

REMARKS**I. General**

Claims 21-55 are currently pending, and claims 21-49 are finally rejected by the current Office Action, mailed May 25, 2004. No claims are amended by this response, and claims 50-55 are new. The issues in the current Office Action are as follows:

- Claims 21-31 and 33-48 are finally rejected under 35 U.S.C. §103(a) over U.S. Patent 5,987,440 (hereinafter, *O'Neil*) in view of the Examiner's personal knowledge.
- Claims 32 and 49 are also finally rejected under 35 U.S.C. §103(a) over *O'Neil* in view of the Examiner's personal knowledge.

Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in light of the remarks contained herein.

II. Improper Final Rejection

The finality of the rejection of claims 21-49 is improper. The claims of a new application may be finally rejected in the first Office Action only if the new application is a continuing application and all claims are drawn to the same invention and would have been properly finally rejected on the grounds and art of record in the next Office Action had they been entered in an earlier application. The present application was submitted in a Request for Continued Examination (RCE), wherein claims 42-49 were added. Claim 42 contains limitations not found in claims 21-41, such as "designating, by the owner, an authorized information source to a trusted party," and "contacting, by the trusted party, the authorized information source to obtain the personal information of the owner." Such features raise new issues and, therefore, claims 42-49 would not have been properly finally rejected on the same grounds and art as the other claims. Accordingly, the finality of the rejection is improper, and Applicants request withdrawal of the finality thereof.

III. New Claims

Support for claim 50 may be found, at least, at pages 4-5 of the specification. Thus, no new matter is added. Claim 50 is allowable, at least, because presently cited art does not teach “tracking, by the information source, behavior of an owner, thereby gathering personal information about the owner,” as recited by claim 50. For example, while *O’Neil* teaches that information may be entered into a personal profile, the reference does not mention or teach that the information is gathered by tracking the information of an owner.

Support for claim 51 may be found, at least, at page 15, lines 8-12 and page 16, lines 16-18 in the specification. Thus, no new matter is added. Claim 51 is allowable, at least, because the cited art does not teach the particular feature recited therein. For instance, *O’Neil* does not teach an owner “providing an identification of the information source,” as recited by claim 51. Accordingly, *O’Neil* does not teach the recited feature of claim 51.

Support for claim 52 may be found, at least, at page 7, lines 5-10; thus no new matter is added. Claim 52 is also allowable, at least, because the cited art does not teach the particular feature recited therein. For instance, *O’Neil* teaches that parties must be members of the Internet community, whereas claim 52 allows the trusted party to “be an entity other than the owner with the capability to validate the personal information.” Accordingly, *O’Neil* does not teach the recited feature of claim 52.

Support for claim 53 may be found, at least, at page 15, lines 8-12, and page 16, lines 16-18 in the specification, and in the original claims. Thus, no new matter is added. Claim 53 is allowable, at least, because the cited art does not teach, “providing, by the owner, a specific identity of an authorized information source to a trusted party,” as recited by claim 53. For example, *O’Neil* does not teach providing an identity of an information source.

Support for claim 54 may be found, at least, at page 4, line 12 through page 5, line 19, of the specification and at claim 21. It should be noted that the feature, “wherein the trusted party and the information source are different entities that do not belong to a common internet community,” is a negative limitation, and because the information source originally disclosed may be any source of personal information generated by or associated with the owner (including on-line services and web browsers), this recited limitation simply covers a subset of those Internet users. Because the limitation does not add any new information sources to the set of possible information sources, the above-recited feature is inherent in the

original subject matter, and no new matter is added. *O'Neil* does not teach that limitation. *O'Neil* teaches that the parties must be members of common Internet communities, claim 54 recites, "wherein the trusted party and the information source are different entities that do not belong to a common internet community," which, accordingly, is not taught by *O'Neil*. Further, Claim 54 is also allowable, at least, because presently cited art does not teach "tracking, by the information source, behavior of an owner, thereby gathering personal information about the owner," as recited by claim 54. For example, while *O'Neil* teaches that information may be entered into a personal profile, the reference does not mention or teach that the information is gathered by tracking the information of an owner.

Support for claim 55 may be found, at least, at claim 21 and page 5, lines 7-19. It should be noted that the feature, "wherein the trusted party and the information source are different entities that do not belong to a common internet community," is a negative limitation, , and because the information source originally disclosed may be any source of personal information generated by or associated with the owner (including on-line services and web browsers), this recited limitation simply covers a subset of those Internet users. Because the limitation does not add any new information sources to the set of possible information sources, the above-recited feature is inherent in the original subject matter, and no new matter is added. Claim 55 is allowable, at least, because *O'Neil* teaches that the parties must be members of common Internet communities, whereas claim 55 recites, "wherein the trusted party and the information source are different entities that do not belong to a common internet community," which, accordingly, is not taught by *O'Neil*.

IV. Rejections of Claims 21-31 and 33-48 Under 35 U.S.C. §103

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicants respectfully assert that the rejection does not satisfy the first and third criteria, as discussed further below.

A. Failure To Teach or Suggest All Limitations**1. Claims 21-31 and 33**

Claim 21 recites, in part, “obtaining the personal information of the owner by an information source, wherein the information source may be any user of the Internet.” *O’Neil*, as modified by the Examiner’s personal knowledge, does not teach or suggest the above-quoted feature of claim 21. The Office Action acknowledges that *O’Neil* fails to teach or suggest the above-quoted feature. The Office Action then states that the system of *O’Neil* can be modified to teach the feature:

“However, *O’Neil* does disclose that the system can be operated on the internet (Fig. 1, C2 L8), and can be accessed by anyone on the Internet through the website address (C4 L25-40), wherein any Internet user may sign up to an E-Metro community based on established rules and regulations (C5 L25-52, C22 L52-58) – which could be established to allow any user on the Internet who makes a request to use the system.”

The Office Action states that any user of the Internet may join a community, and therefore, that the above-quoted limitation is satisfied. Such reasoning is incorrect, however. That any Internet user can potentially become a member of a community is irrelevant because registering is required to become a member. See Col. 7, line 53 through Col. 8, line 13. Registering causes a user to become part of a subset of Internet users, and as a result, a member is not “any user of the Internet.” Therefore, the modification of *O’Neil* by the Examiner’s personal knowledge does not teach or suggest each and every feature of claim 21.

Dependent claims 22-31 and 33 each depend either directly or indirectly from independent claim 21 and, thus, inherit all of the limitations of independent claim 21. Thus, *O’Neil*, as modified by the Examiner’s personal knowledge, does not teach or suggest all claim limitations of claims 22-31 and 33. It is respectfully submitted that dependent claims 22-31 and 33 are allowable at least because of their dependence from claim 21 for the reasons discussed above. Accordingly, Applicants request withdrawal of the rejections of claims 21-31 and 33.

2. Claims 34-41

Claim 34 recites, in part, “wherein the at least one information source may be any user of the Internet.” Applicants assert that the modification of *O’Neil* by the Examiner’s personal knowledge does not teach the above-quoted feature of claim 34. The Office Action acknowledges that *O’Neil* does not teach or suggest “wherein the at least one information source may be any user of the Internet.” The Office Action relies on the Examiner’s personal knowledge to modify *O’Neil* to teach the feature. Even if any user of the Internet could potentially become a member of a community, a registered member is still only a subset of the entirety of Internet users, and thus, the combination fails to teach or suggest, “wherein the at least one information source may be any user of the Internet,” as claim 34 recites. Accordingly, the cited modification does not teach or suggest each and every feature of claim 34.

Dependent claims 35-41 each depend either directly or indirectly from independent claim 34 and, thus, inherit all of the limitations of independent claim 34. Thus, *O’Neil*, as modified by the Examiner’s personal knowledge, does not teach or suggest all claim limitations of claims 35-41. It is respectfully submitted that dependent claims 35-41 are allowable at least because of their dependence from claim 34 for the reasons discussed above. Accordingly, Applicants request withdrawal of the rejections of claims 35-41.

3. Claims 42-48

Claim 42 recites, in part, “designating, by the owner, an authorized information source to a trusted party.” Applicants assert that the above-quoted feature of claim 42 is not taught or suggested by the proposed modification of *O’Neil* by the Examiner’s personal knowledge. It appears from the language of the Office Action, that the Office Action equates the authorized information source with a buyer of personal information and equates a trusted party with a secondary buyer to whom the information is disseminated from the original buyer. If such a characterization is used, the proposed combination does not teach or suggest each and every feature of claim 42. For instance, nowhere in *O’Neil* or in the Examiner’s personal knowledge is it taught that an owner designates a buyer to a secondary buyer. In fact, it is not taught or suggested that the transitive rules discussed at Col. 7, lines 47-52 allow an owner to designate a secondary buyer. Thus, while *O’Neil* mentions that information may

be disseminated beyond a first buyer, *O'Neil* never mentions that the secondary buyer may be designated by the owner for purposes of dissemination.

In an alternative application of *O'Neil* wherein the owner is a member of an e-community, an authorized information source is a certificate issuer, and a trusted party is the e-community, the proposed combination still does not teach or suggest the above-quoted feature of claim 42. While *O'Neil* teaches that certificates may be used to verify information supplied to the e-community by the member, it does not teach or suggest that the member may designate the certificate issuer as authorized. See Col. 6, lines 7-23. In fact, *O'Neil* never mentions how such certificates may be entered into the member's profile or whether it requires designation of an authorized source to do so. Thus, *O'Neil* does not teach or suggest "designating, by the owner, an authorized information source to a trusted party," as required by claim 42.

Thus, there is no application of *O'Neil* that teaches or suggests the above-recited feature of claim 42. While the Examiner applies personal knowledge to allege that membership in a community may be available to any Internet user, such an allegation is irrelevant because such feature is not recited by the claim. Further, the Examiner's personal knowledge is not alleged to teach "designating, by the owner, an authorized information source to a trusted party," as required by claim 42. Accordingly, *O'Neil* as modified does not teach or suggest each and every feature of claim 42.

Dependent claims 43-48 each depend either directly or indirectly from independent claim 42 and, thus, inherit all of the limitations of independent claim 42. Thus, *O'Neil*, as modified by the Examiner's personal knowledge, does not teach or suggest all claim limitations of claims 43-48. It is respectfully submitted that dependent claims 43-48 are allowable at least because of their dependence from claim 42 for the reasons discussed above. Accordingly, Applicants request withdrawal of the rejections of claims 42-48.

B. Lack of Motivation to Combine

The Office Action admits that *O'Neil* fails to teach or suggest having the information source be any user of the Internet. The Office Action further states that *O'Neil* may be modified to remove rules and regulations, thereby eliminating the need for a user to register

to interact with an e-community, such that anyone on the Internet may use the system. The motivation for making the modification is stated as follows:

“It would have been obvious ... to simply allow anyone on the Internet to use the system (website) disclosed [sic] by *O’Neil*, as it would simply be a matter of removing security precautions (registration) – for the purpose of reduction system set-up and operational maintenance costs.”

It is well settled that it is impermissible to modify a reference where the proposed modification would change the principle of operation of the reference, see M.P.E.P. § 2143.01. The main features of the system taught by *O’Neil* are security features (such as identity verification in the registration process), which provide that trusted members are “encapsulated” and that the information is verified and secure. See Abstract, Col. 2, lines 23-34, Col. 4, lines 41-45, and Col. 15, lines 35-52, *inter alia*. Removing security precautions and/or the registration process, as suggested by the Office Action, would undermine the entire purpose of the system, which is to provide members with trusted information and secure ways to disseminate the information. Thus, such a modification of *O’Neil* changes the principle of operation thereof, and, accordingly, is improper.

Further, a reference must be considered in its entirety, including portions that teach away from the claimed invention. See M.P.E.P. §2141.02. *O’Neil* teaches away from the proposed modification. See such passages as Col. 1, lines 27-31, which states that rules are necessary to prevent interception and misuse of information and to provide assurance of identity, and Col. 2, lines 23-34, which states that enforcing such rules provides privacy and informational self-determination. These teachings would lead one of ordinary skill in the art to avoid removing the rules and regulations from the system of *O’Neil*.

Accordingly, no valid suggestion has been made as to why a modification of *O’Neil* is desirable. Therefore, the rejection of claims 31-31 and 33-48 should be withdrawn.

C. Rejections of Claims 32 and 49 Under 35 U.S.C. §103

As explained above, *O’Neil*, as modified, does not teach or suggest each and every feature of claim 21. Claim 32 depends from claim 21, and, thus, inherits all of the limitations

of claim 21. The Examiner's statement of personal knowledge on page 5 of the Office Action is not used to cure this deficiency of the rejection. Therefore, the proposed modification of *O'Neil* does not teach or suggest all limitations of claim 32.

Moreover, as explained above, *O'Neil*, as modified, does not teach or suggest each and every feature of claim 42. Claim 49 depends from claim 42, and, thus, inherits all of the limitations of claim 42. The Examiner's statement of personal knowledge on page 5 of the Office Action is not used to cure this deficiency of the rejection. Therefore, the proposed modification of *O'Neil* does not teach or suggest all limitations of claim 49. Accordingly, Applicants request withdrawal of the rejections of claims 32 and 49.

V. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe that a fee of \$366.00 is due with this response. However, if any additional fees are due, please charge Deposit Account No. 08-2025, under Order No. 10992073-3, from which the undersigned is authorized to draw.


Dated: July 23, 2004

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Dated: July 23, 2004

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